

REMARKS/ARGUMENTS

Claims 1-19 are pending in this application, with claims 1 and 13 being the only independent claims. Claims 1, 3, 5-7, 10, 12-14, and 16-17 are amended. Claims 18-19 are added. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Claims 1-17 stand rejected under 35 U.S.C. §103 as obvious over U.S. Patent No. 5,754,656 (Nishioka) in view of U.S. Patent No. 6,209,095 (Anderson).

The present invention relates to a method and system for signing an electronic form using a mobile station. According to the present invention, a local payment machine (LPM) 2 generates the material to be signed, computes a hash code H1 from the material, and then transfers the material and the hash code to a mobile station (see page 8, line 34 - page 9, lines 3; page 9, lines 28-31; and Fig. 1 of the present application). The material and hash code are signed by the user using the mobile station (page 9, line 36 - page 10, line 1). A display on the mobile station allows the user to check whether the information in the material is correct before the user signs the material and hash code (page 11, lines 14-18). After signing by the user, the material with the digitally signed hash code may be authenticated (page 10, lines 1-10).

Independent claim 1 is now amended to include reference to “a payment machine” and now recites “computing, in a payment machine, a first hash code for the material to be signed, the material to be signed including the form, an identifier of the form, shared information, and/or information in essential fields of the form” and “transferring the material to be signed and the first hash code from the payment machine to the mobile station”.

Nishioka fails to teach or suggest the above limitations because Nishioka discloses that the material and hash code are computed in a user possessed terminal or station and then

transferred to a smart card inserted in the user possessed terminal or station. In contrast, the amended claims now expressly recite that the first hash code is computed in a payment machine and then transferred to the mobile station.

Nishioka discloses an electronic shopping method. According to Nishioka, a user site apparatus 10, i.e., a terminal, is operated by a user who has a smart card 20 (see Fig. 1, and col. 9, lines 3-6 of Nishioka). A retail store site apparatus 30 is installed in a retail store and is connected to the user site apparatus 10 by a communication line 50 for introducing various products to the user (col. 9, lines 6-9). Nishioka teaches that the user site apparatus 10 corresponds to a terminal possessed by a user in which the smart card 20 is inserted (col. 9, lines 16-20).

In the Nishioka shopping method, a user inserts the smart card into the user site apparatus 10, i.e., the user possessed terminal, and utilizes the user site apparatus 10 to select items for purchase from the retail store site apparatus 30 which is connected to the user site apparatus 10 by the communication line 50 (col. 10, lines 38-43). The user then activates a document producing unit 102 on the user site apparatus 10 which produces a written order for items that the user wishes to purchase from the retail store site apparatus 30 (col. 10, lines 44-52). A key producing unit and cipher producing unit in the user site apparatus 10 produce a key K and a cipher C1 which is output to the smart card 20 (col. 10, line 53 - col. 11, line 1). The key and cipher are used to send a ciphered message to the retail store site apparatus 30 (col. 11, lines 15-18).

The Examiner alleges that the step of computing a first hash code for the material is disclosed at col. 13, lines 21-23 and col. 21, lines 58-61 of Nishioka. However, the portion of Nishioka referred to by the Examiner discloses that the user site apparatus 10 generates the hash codes. Since the user site apparatus 10 of Nishioka is a terminal possessed by a user (see col. 9, lines 16-17 of Nishioka), the user site apparatus can not be considered to be the claimed payment

machine which subsequently transfers the material and hash code to the mobile station, as expressly recited in independent claim 1.

The Examiner further alleges in the Office Action that the step of “transferring the material to be signed and the first hash code from the payment machine to the mobile station” is disclosed at col. 22, lines 3-5. However, that portion of Nishioka merely states that the hash value is transferred from the user site apparatus 10 to the smart card 20. The Examiner considers the smart card to be the recited mobile station. As described above, the smart card 20 is installed in a slot on the user site apparatus 10 (see col. 21, lines 1-3). Since Nishioka discloses that the smart card 20 must be inserted in a slot of a terminal or station for use, the smart card 20 itself can not be considered to be the mobile station recited in the claims. Accordingly, Nishioka fails to disclose the limitation “transferring the material to be signed and the first hash code to the mobile station”, as expressly recited in independent claim 1.

Anderson fails to teach or suggest that which Nishioka lacks. Anderson discloses a signing method for computer-based document signing. According to Anderson, separate hashes are calculated for two sections of a document (see Fig. 35; and col. 20, lines 16-31 of Anderson). The hashed sections are placed consecutively in a message and a hash is calculated for the combined sections which is signed. This ensures that no third party has tampered with any of the parts of the document, i.e., the final signature ensures the authenticity of the entire document. Anderson also uses cards, i.e., PCMCIA cards, which the Examiner alleges to be a mobile station. However, Anderson specifically states at col. 30, lines 50-54 that the PCMCIA card is a separate, narrowly defined, secure electronic environment used in conjunction with a terminal such as a personal computer. Anderson further states that information passes back and forth between the PCMCIA card and the terminal or workstation (col. 30, lines 53-54). Since the

PCMCIA card can not be used without a terminal or station, this portion of Anderson further demonstrates that the smart card or PCMCIA card can not be considered to be the mobile station which is recited in independent claim 1.

For all of the above reasons, independent claim 1 is deemed to be allowable over the combined teachings of Nishioka in view of Anderson.

Independent claim 13 is directed to a system including a payment machine and a mobile station and includes similar limitations to the above-cited limitations of independent claim 1. Accordingly, independent claim 13 should also be considered allowable over Nishioka in view of Anderson for the same reasons as is independent claim 1.

In the rejection of claim 13, the Examiner alleges that the user site apparatus 10 of Nishioka can be considered to be the recited payment machine because it is inherent that the user site apparatus is where the payment takes place. As described above, Nishioka discloses at col. 9, lines 16-17 that the user site apparatus 10 is a terminal which the user possesses. Accordingly, in Nishioka payment does not take place at the user site apparatus 10; rather, payment takes place at the retail store site apparatus 30. This is shown, for example, in Fig. 6 of Nishioka in which the user sends information from the user site apparatus to the retail store site apparatus which in turn authenticates the information. Thus, the user site apparatus 10 can not be considered to be applicants' recited payment machine. Accordingly, independent claim 13 is deemed to be allowable over Nishioka and Anderson for these additional reasons.

Dependent claims 2-12 and 14-19 are allowable for the same reasons described above with respect to independent claims 1 and 13, as well as for the additional recitations contained therein.

New claims 18 and 19 further recite that the mobile station includes a display configured to present at least a portion of the material to a user. The smart card of Nishioka or the PCMCIA card of Anderson can not be considered to be the mobile station having a display as recited in these claims. Accordingly, claims 18 and 19 are allowable for at least these additional reasons. Dependent claims 10 and 16 are amended to depend directly from new claims 18 and 19.

Dependent claim 3 recites “wherein the material to be signed is generated from an identifier of the form and information in the essential fields of the form”. In the rejection of claim 3, the Examiner cites col. 20, lines 29-32 and col. 21, lines 10-11 of Anderson. These sections relate to signing multiple parts or blocks of a message that are bound together, but fail to teach or suggest how the material is generated. Accordingly, the rejection of dependent claim 3 should be withdrawn.

Dependent claim 5 recites “the material transferred from the payment machine to the mobile station for signature is also transferred from the payment machine to a second party” and “the signed material is transferred from the mobile station to the second party, whereupon the second party performs said step of verifying the authenticity of the signature”. The Examiner refers to col. 20, lines 29-32 and col. 21, lines 10-11 of Anderson which relate to signing multiple parts or blocks that are bound together. This section of Anderson fails to teach or suggest anything about transferring the material and hash code to a second party. Accordingly, the rejection of dependent claim 5 should be withdrawn.

Dependent claim 7 recites “wherein the form is generated using a pre-agreed form template provided with an identifier, the information in the essential fields of the form being filled in the form template before it is transferred to the mobile station”. In the rejection of claim 7, the Examiner cites Nishioka, col. 21, lines 6-14 and 62-65, and col. 22, lines 40-42. These portions of

Nishioka fail to disclose a pre-agreed form template with an identifier. Accordingly, the rejection of dependent claim 7 should be withdrawn.

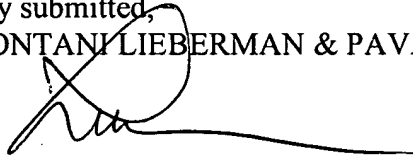
Dependent claim 10 recites "wherein the material or part of the material is presented on the display in the mobile station before the material is signed". The Examiner cites col. 20, lines 29-32 and col. 21, lines 10-11 of Anderson which relate to signing multiple parts or blocks that are bound together and have nothing whatsoever to do with presenting material to a user. Thus, the rejection of dependent claim 10 should be withdrawn.

Dependent claim 11 recites "wherein the mobile station is started in signature mode before the transfer of the material into the mobile station". The Examiner cites Nishioka, col. 12, lines 27-28 which merely states that authentication is effected using a digital signature without keys. This section of Nishioka does not disclose in what mode a mobile station starts. The rejection of dependent claim 11 should also be withdrawn.

In view of the above amendments and remarks, this application is deemed to be in condition for allowance, and early notice to that effect is earnestly solicited.

Respectfully submitted,
COHEN PONTANI LIEBERMAN & PAVANE LLP

By



Lance J. Lieberman
Reg. No. 28,437
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

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